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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,636	10/26/2001	Robert Brondijk	206	1426

31665 7590 03/01/2006

PATENT DEPARTMENT  
MACROVISION CORPORATION  
2830 DE LA CRUZ BLVD.  
SANTA CLARA, CA 95050

EXAMINER
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PERUNGAVOOR, VENKATANARAY

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/014,636

Applicant(s)

BRONDIJK ET AL.

Examiner

Venkatanarayanan Perungavoor

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-64 and 66-86 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-64 and 66-86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

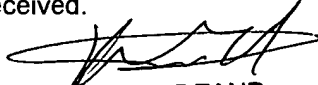
**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
KAMBIZ ZAND  
PRIMARY EXAMINER

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/31/2006 has been entered.

### ***Response to Arguments***

2. The Applicant's arguments regarding Claim 1 are not persuasive. As Ogino et al.(U.S. Patent 6,571,220 B1) discloses the performing certain copy-once functionality on material before searching for copy-never indication see Fig. 16 item 1, 43. And further, the Applicant's arguments regarding direction of data flow is not relevant. And further the Applicant is reminded, *In Syntex (U.S.A.) LLC V. Apotex Inc.*, 74 USPQ2d 1823 (CA FC 2005), "Prior art reference teaches away from claimed invention if it suggests that developments flowing from its disclosures are unlikely to produce objective of invention, and what reference teaches person of ordinary skill in art is not limited to what reference specifically 'talks about' or what is specifically 'mentioned' or 'written' in reference;...". Moreover, a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d

Art Unit: 2132

1843(Fed. Cir.), cert. Denied, 493 U.S. 975(1989). See also *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23(Fed. Cir. 1998) (The court held that the prior art anticipated the claims even though it taught away from the claimed invention.)

3. And further, the Applicant's arguments regarding Claim 1 about remaking ability is not persuasive. As Ogino discloses the rewriting unit see Fig. 17 item 206 and the lacing of secure channel is also disclosed see Col 7 Ln 49-51.
4. The Applicant's arguments regarding Claim 15,16,17 and 19 are not persuasive. As Ogino discloses the IEEE 1394 standards which includes expansion boards see Col 19 Ln 57-60.
5. The Applicant's arguments regarding Claim 22, 42, 64 are not persuasive see arguments for Claim 1 above.
6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Response to Amendment***

***Claim Rejections - 35 USC § 102***

7. Claim 1-2, 4-7, 9-34, 36-39, 41-54, 56-64,66-80 rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,571 ,220 B1 to Ogino et al.
8. A system for providing protected copying of material, comprising: a preprocessing unit having an output and capable of providing copy-once functionality on a material before providing said material on said output- wherein said copy-once functionality includes searching for a copy-once indication and a copy-no- more indication in said material not providing said material on said preprocessing unit output if said copy-no-more indication is found and remarking said material with said copy-no-more indication before providing said material on- said preprocessing unit output if said copy-once indication is found and said copy-no-more indication is not found(see Col 10 Ln 1-6 & Col 5 Ln 39-47 & Fig.14 item S305) and a recording unit coupled through a secure channel to said preprocessing unit output to receive said material from preprocessing unit and capable of searching for a copy-never indication in said material provided on said preprocessing unit output and copying said material unless said copy-never indication is found but lacking capability to remark said material with a copy-no-more indication(Col 6 Ln 39-51& Col 15 Ln 48-65 & Fig.19 item S401 & S407).

9. Regarding Claim 2, Ogino discloses copy-never watermark is embedded within the material see Column 6 Line 23-33.
10. Regarding Claim 4 and 5, Ogino discloses the copy-one and copy-no-more watermark embedded within the material see Column 6 Line 8-15.
11. Regarding Claim 6 and 7, Ogino discloses the secure channel and checking of watermark information and also of key exchange see Column 6 Line 58-67.
12. Regarding Claim 9, Ogino discloses the searching for watermarks that represent "copy-once" see Column 12 Line 1 1-29.
13. Regarding Claim 10 and 12, Ogino discloses the step of finding the copy-once watermark after establishing secure channel see Col 14 Line 53-60.
14. Regarding Claim 11, Ogino disclose the step establishing secure connection before finding watermarks see Column 6 Line 52-64.
15. Regarding Claim 13, Ogino discloses the preprocessing unit acting as though it had found the copy-once indication see Column 6 Line 39-51 .

Art Unit: 2132

16. Regarding Claim 14, Ogino disclose the audio-visual content see Col 8 Line 29-40.

17. Regarding Claim 15, 16, 17, 18, 82, and 83, The "preprocessing unit personal computer is included on an expansion board of a personal computer" is met by Ogino et al. Col 15 Line 53-65.

18. Regarding Claim 19, The "network appliance coupled to a recording unit" is met by Ogino et al. see Column 14 Line 57-60.

19. Regarding Claim 20, The "preprocessing unit is included in a set-top box coupled to said recording unit" is disclosed by Ogino et al. see Column 7 Line 24-37.

20. Regarding Claim 21, 84, Ogino disclose DVD recordable drive see Column 6 Line 15-21.

21. Regarding Claim 22, A method implemented in a recording unit for providing protected copying of material, comprising: detecting if a copy-never or copy-once indication is provided with a material (Col 6 Line 8-15) if said copy-never indication is detected, then not allowing copying of said material (Col 6 Line 45-51) if neither said copy-never nor said copy-once indication is detected, then allowing copying of said material (Col 12 Line 11-18) and if said copy-once

indication is detected, then transmitting information of said detection of said copy-once indication back to a sender of said material provided a secure channel is established with said sender, otherwise not allowing copying of said material(Col 12 Line 19-29).

22.Claim 23 is rejected under the same rationale as Claim 14 above.

23.Claim 24 is rejected under the same rationale as Claim 2 above.

24.Claim 25 is rejected under the same rationale as Claim 4 above.

25.Claim 26 is rejected under the same rationale as Claim 21 above.

26.Claim 27 is rejected under the same rationale as Claim 15 above.

27.Claim 28 is rejected under the same rationale as Claim 16 above.

28.Claim 29 is rejected under the same rationale as Claim 17 above.

29.Claim 30 is rejected under the same rationale as Claim 19 above.

30.Claim 31 is rejected under the same rationale as Claim 20 above.

31.Regarding Claim 32, The "method according to claim 22, wherein said

transmitting information of said detection of said copy-once indication back to a sender of said material provided a secure channel is established with said sender, otherwise not allowing copying of said material, comprises: if said copy-once indication is not said copy-once indication is detected, then detected and a secure channel already established with said sender of said material, then transmitting information of said detection of said copy-once indication back to



said sender of said material, and said secure channel is not already established with said sender of said material, then not allowing copying of said material" is met by Ogino et al. see Col 10 Line 53-64 & Column 9 Line 54-58.

32. Regarding Claim 33, The "method according to claim 22, wherein said transmitting information of said detection of said copy-once indication back to a sender of said material provided a secure channel is established with said sender, otherwise not allowing copying of said material, comprises'. "if said copy-never indication is not detected and said copy-once indication is detected, then establishing a secure channel with said sender of said material', if said secure channel cannot be established, then not allowing copying of said material', and if said secure channel is established, then transmitting information of said detection of said copy-once indication back to said sender of said material" is met by Ogino et al. see Col 10 Line 53-64 & Column 9 Line 54-58.

33. Claim 34 is rejected under the same rationale as Claim 7 above.

34. Regarding Claim 36, 37, and 38, Ogino et al. discloses transmitting information only when allowed based on watermarks and done thorough an secure channel see Col 10 Line 53-64 & Column 9 Line 54-58.

35. Claim 39 is rejected under the same rationale as Claim 7 above.

36. Claim 41 is rejected under the same rationale as Claim 5 above.

37. Regarding Claim 42, A recording unit for providing protected copying of material, comprising: an input channel receiving a material for copying from the sending unit(Col 10 Line 1 1-18 & Fig. 19 item S401 & S407), a primary detector coupled to said input channel to detect a copy-never indication and a copy-once indication are provided with said material(Col 9 Line 66-Col 10 Line 6), and compliance logic coupled to said primary detector and configured such that if said copy-never indication is detected, then preventing said material from being copied, and if neither said copy-never nor said copy-once indication is detected, then allowing said material to be copied(Col 10 Line 47-641.

38. Claim 43 is rejected under the same rationale as Claim 14 above.

39. Claim 44 is rejected under the same rationale as Claim 2 above.

40. Claim 45 is rejected under the same rationale as Claim 4 above.

41. Claim 46 is rejected under the same rationale as Claim 21 above.

42. Claim 47 is rejected under the same rationale as Claim 15 above.

43. Claim 48 is rejected under the same rationale as Claim 16 above.

44. Claim 49 is rejected under the same rationale as Claim 17 above.

45. Claim 50 is rejected under the same rationale as Claim 19 above.

46. Claim 51 is rejected under the same rationale as Claim 20 above.

47. Claim 52 and 53 are rejected under the same rationale as Claim 32 and 33, respectively.

48. Claim 54 is rejected under the same rationale as Claim 7 above.

49. Claim 60 is rejected under the same rationale as Claim 5 above.

50. Regarding Claim 61, 62 and 63 compliance logic being processor, state machine and logic circuit are substantially taught by Ogino et al. see Column 12 Line 42-48 & Column 11 Line 36-43.

51. Regarding Claim 64, A system for providing protected copying of material comprising: a preprocessing unit having at least one input channel for receiving material and an output channel for providing an output wherein said material is provided as said output neither a copy-never indication nor a copy-once indication is detected as being provided with said material, said material is not provided as said output if either said copy-never indication is detected as being provided or said copy-once indication and a copy-no-more indication are both detected as being provide with said material, and an encrypted version of said material including said copy-no-more indication is provided as said output and said output channel is configured to be a secure channel if said copy-once indication is detected and said copy-no-more indication is not detected prior to said inclusion with said material (Abstract & Col 11 Line 65-Col 12 Line 10); and a recording unit coupled to said output channel of said preprocessing unit and

Art Unit: 2132

including a primary detector to detect if a copy-never indication and a copy-once indication are provided with said preprocessing unit's output (Col 12 Line 42-48); and compliance logic coupled to said primary detector and configured such that if said copy-never indication is detected then not allowing said preprocessing unit's output to be copied and if neither said copy-never nor said copy-once indication is detected then allowing said preprocessing unit's output to be copied and if said copy-once indication is detected- then establishing a secure channel-with said preprocessing unit and passing information of said detection of said copy-once indication back to said preprocessing unit over said secure channel(Col 13 Ln 15-34 & Col 14 Ln 24-41 & Col 7 Ln 49-51).

52.Regarding Claim 66, The "preprocessing unit receives said information of said detection of said copy-once indication passed back by said recording unit, and provides said encrypted version of said material including said copy-no-more indication as said output over said secure channel" is met by Ogino et al. see Column 12 Line 19-33.

53.Regarding Claim 67, The "recording unit further includes a secondary detector to detect if a copy-no-more indication is provided with said preprocessing unit output, and said compliance logic is further configured such that if said copy-once indication is detected and said copy-no-more indication is not detected, then passing information of said detection of said copy-once indication back to

Art Unit: 2132

said preprocessing unit over said secure channel if said secure channel has already been established" is met by Ogino et al. see Column 6 Line 8-51 .

54. Regarding Claim 68, The "recording unit further includes a secondary detector to detect if a copy-no-more indication is provided with said preprocessing unit output, and said compliance logic is further configured such that if said copy-once indication is detected and said copy-no-more indication is not detected, then establishing a secure channel with said preprocessing unit and passing information of said detection of said copy- once indication back to said preprocessing unit over said secure channel" is met by Ogino et al. see Column 6 Line 39-64.

55. Claim 69 is rejected under the same rationale as Claim 14 above.

56. Claim 70 is rejected under the same rationale as Claim 2 above.

57. Claim 71 is rejected under the same rationale as Claim 4 above.

58. Claim 72 is rejected under the same rationale as Claim 5 above.

59. Claim 73 is rejected under the same rationale as Claim 15 above.

60. Claim 74 is rejected under the same rationale as Claim 19 above.

61. Claim 75 is rejected under the same rationale as Claim 20 above.

62. Claim 76 is rejected under the same rationale as Claim 21 above.

63. Claim 77 is rejected under the same rationale as Claim 7 above.

Art Unit: 2132

64. Claim 78, 79, and 80 is rejected under the same rationale as Claim 61, 62 and 63 above respectively.

65. Regarding Claim 81, Ogino discloses the expansion board(as disclosed in Applicant's specifications see Par. 0044) having an input for receiving material and an output , expansion board configured to search for copy-once indication and copy no more indication, not provide material to output if copy-no-more is found and remark material with copy-no-more if copy-once is found and copy-no more is found (see Col 10 Ln 1-6 & Col 5 Ln 39-47 & Fig.14 item S305); an "media drive" coupled to expansion board configured to search for copy-never indication in material and copy unless copy-never is found, but lacking capability to remark with copy-no more (see Col 6 Ln 39-51& Col 15 Ln 48-65 & Fig.19 item S401 & S407).

***Claim Rejections - 35 USC § 103***

66. Claim 8, 35,40,55 is rejected under 35 U.S.C. 103(a) as being unpatentable over U S Patent 6571220 B1 to Ogino et al. in view of NPL to Stalling

67. Ogino does not disclose the key exchange being done via Diffie-Hellman key exchange. However, Stallings discloses the use of Diffie-Hellman key exchange for use between two communicating devices see pp 296 paragraph 2-3. It would be obvious to one having ordinary skill in the art at the time of the invention to

Art Unit: 2132

include Diffie-Hellman in the invention of Ogino in order to use an secure key exchange as taught in Stallings see pp 296 paragraph 2-3.

68. Claim 35 is rejected under the same rationale as Claim 8 above.

69. Claim 40 is rejected under the same rationale as Claim 8 above.

70. Claim 55 is rejected under the same rationale as Claim 8 above.

71. Regarding Claim 85 and 86, Ogino discloses the CD and solid-state memory recordable unit see Col 1 Ln 11-33.

### ***New Matter Rejection***

72. The amendment filed 1/31/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the media drive disclosed in Claims 81-86 are not disclosed in the original specifications, the closest interpretation that can be conceived is "DVD recordable drive" see Par. 0032 of the published application. The discloses media drive is broader than what is disclosed in the specifications, as it could encompass DVD, CD, CD-ROM drives or any variation thereof.

Applicant is required to cancel the new matter in the reply to this Office Action.

Art Unit: 2132

**Conclusion**

73. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Venkatanarayanan Perungavoor whose telephone number is 571-272-7213. The examiner can normally be reached on 8-4:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

74. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KAMBIZ ZAND  
PRIMARY EXAMINER

Venkatanarayanan Perungavoor  
Examiner  
Art Unit 2132

VP  
2/17/2006